

Appl. No. : 09/908,994  
Filed : July 17, 2001

### REMARKS

Claims 10-20 have been rejected. Claims 10-28 are pending. New Claims 21-28 have been added. Support for the new claims can be found throughout the specification and original claims, for example, in original Claims 10-20. No new matter has been added by the new claims.

#### *Incorporation by Reference*

The Examiner objected to the statement in the specification incorporating documents cited in the specification by reference. Applicants have not submitted a laundry list of references and merely incorporated the entirety of each reference indiscriminately. Rather, the Applicants have explicitly referred to particular references in particular contexts; and submit that this is consistent with M.P.E.P. § 608.01(p)I referred to by the Examiner. There is no prohibition against incorporating entire references. Further, Applicants note that *Ex Parte Raible* is not relevant here because there is no §112 issue and *Ex Parte Raible* does not stand for the proposition that entire documents cannot be incorporated by reference. Moreover, because the specification, when incorporating the references, clearly identifies the relevance of each reference (and thus why it is being incorporated), the subject matter incorporated by reference has been clearly identified to one of skill in the art.

#### 35 U.S.C. §103

Claims 10-20 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. No. 5,849,486 (“Heller”) in view of U.S. Pat. No. 5,607,646 (“Okano”). The Examiner has interpreted Claim 10 as “encompassing the isolation of from one to an infinite number of nucleic acid sequences, and that at a minimum, two different capture moieties are to be present and are bound at two different locations on a support that can virtually any [sic] shape but can act as a flow path for a mixture of nucleic acids capable of flowing.” (Page 5, OA).

The Examiner found that Heller teaches a method of flowing a sample across reactive members of a chip. Furthermore, the Examiner asserted that Heller teaches modifying various physical properties to alter selective binding and release. Okano was characterized by the Examiner as teaching that temperature can be adjusted in order to facilitate the separation of captured polynucleotides. Applicants respectfully traverse the Examiner’s rejection.

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In order to establish a *prima facie* case of obviousness, each of the claim limitations must be taught in the art, there must be a reasonable expectation of success, and there must be some motivation to modify or combine the references. (M.P.E.P. §2143). As discussed below, not all of the elements have been taught and no reason for modifying the cited references has been provided. Furthermore, without a teaching of each of the elements, there can be no reasonable expectation of success. Thus, a *prima facie* case of obviousness has not been established.

*The rejection and the cited art do not teach 1) separate supports or 2) altering one support without altering another support.*

As an initial point, Applicants note that the Examiner mischaracterized the claimed invention. The Examiner stated that two different capture moieties are bound to “two different locations on a support that can virtually any shape but can act as a flow path...” As noted above, Claim 10 clearly recites a plurality of solid supports, which are located in series in the flow path. The Examiner’s attention is drawn to Figures 1-4 of the instant application, which demonstrate one such embodiment of a plurality of solid supports in a series.

The references (and the discussion in the Office Action as well) involve a single support or solid support surface that contains multiple areas with different probes. Thus, the references, alone or in combination, do not teach or suggest each of the elements of Claim 10, the independent claim from which all other claims depend.

In addition to failing to teach a method utilizing separate solid supports, the rejection and the art fail to teach or suggest altering a physical property of one support without altering the same physical property of another support. The claimed method recites altering a physical property of a physical support without altering the same physical property of at least one other support (again, the supports are in series in a flow path). Again, in the references cited, there is only one support and thus, none of the references teach or suggest this element of Claim 10.

In addition to no reference being supplied that teaches the above discussed elements, the Examiner has provided no motivation for why one would have altered the methods taught in the cited references to develop the claimed invention. Furthermore, without a teaching of the elements and motivation to modify the cited references, there can be no expectation of success.

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As the art of record and the rejection do not 1) provide each of the elements of the claimed invention, 2) provide any motivation to modify the references to arrive at the claimed invention or 3) establish a reasonable expectation of success, a *prima facie* case of obviousness has not been established. Applicants respectfully request that the rejection be withdrawn and Claims 10-20 allowed. Applicants note that new Claim 21, from which new Claims 22-28 depend, includes the elements recited in current Claim 10. Thus, new Claims 21-28 are also novel and nonobvious for the reasons outlined above. No additional search should be required for the new Claims as Claim 21 recites the elements recited in original Claims 10-12.

In view of the foregoing remarks, Applicants respectfully submit that the pending claims are in condition for allowance and request the same. If, however, some issue remains that the Examiner feels can be addressed by Examiner Amendment, the Examiner is cordially invited to call the undersigned for authorization. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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